

REMARKS

This paper is filed in response to the official action dated April 10, 2007 (hereinafter, the official action).

Claims 54-63, and 70 were pending. Claims 54-60, and 62-63 have been rejected. Claim 61 has been objected to, but is allowable in substance. By this amendment, claim 54 is amended and claim 58 is canceled. As a result, claims 54-57, 59-63, and 70 are pending and at issue. Support for the amendments to claim 54 may be found in the specification as originally filed and in claim 58 as originally filed. No new matter is added.

The applicants thank the examiner for the allowance of claim 70.

Claims 54-60, 62, and 63 have been rejected under 35 U.S.C. §103 as obvious over U.S. Patent No. 4,911,569 to Hashimoto et al. ("Hashimoto") in view of U.S. Patent No. 4,617,697 David ("David"). The applicants respectfully traverse the rejections of claims 54-60, 62, and 63. Reconsideration of the application, as amended, is solicited in view of the following remarks.

Each of claims 54-60, 62, and 63 now recites a writing instrument comprising, in part, a deformable sleeve having a base and an outer membrane, "respective ends of the base and outer membrane engaging to form an annular sealable passageway therebetween ... respective ends of the base and outer membrane being oriented in the same direction and facing away from [a] second end of [an] elongate body," and "a formable material disposed through the annular sealable passageway and into the cavity."

Two of the three requirements for establishing a *prima facie* case of obviousness are: (1) "the prior art reference (or references when combined) must teach or suggest all the claim limitations;" and (2) "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." See M.P.E.P. § 2142 and §2143; see also *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Both Hashimoto and David fail to disclose or suggest a writing instrument having a deformable sleeve that includes "respective ends of the base and outer

membrane engaging to form an annular sealable passageway therebetween ... respective ends of the base and outer membrane being oriented in the same direction and facing away from [a] second end of [an] elongate body” and “a formable material disposed through the annular sealable passageway and into the cavity,” as recited in each of the pending claims 54-60, 62 and 63.

As acknowledged in the official action, Hashimoto fails to disclose or suggest a writing instrument comprising “an annular sealable passageway,” as recited in claims 54-60, 62 and 63. *See* the official action, page 3. Rather, Hashimoto discloses a writing instrument comprising an elastic envelope 35 having an inner wall 44 and an outer wall 5 that are separated by a front end wall 45 at one end and a structural element 52, 36, 37 (*see* Figs. 9-11, col. 10, lines 23-38; Figs. 12-13 and col. 12, lines 4-11; and Figs. 14 and 15 and col. 12, lines 21-29) disposed opposite the front end wall. Therefore, in each of the embodiments shown in Hashimoto, the ends of the inner wall 44 and the outer wall 5 are separated by a structural element and thus do not form “an annular sealable passageway,” as recited in each of pending claims 54-60, 62, and 63.

Even if the inner wall 44 and the outer wall 5 (which are separated by a front end wall 45 and a structural element 52, 36, 37) could be considered to form a sealable passageway, any ends which “engage” are necessarily oriented in opposite directions. *See* Hashimoto, Fig. 9. In other words, any ends of the elastic envelope 35 that would or could engage one another necessarily face away from one another and therefore do not form a “second end,” as recited in each of the pending claims. To the contrary, each of claims 54-60, 62, and 63 recite “respective ends of the base and outer membrane being **oriented in the same direction and facing away from** the second end of the elongate body.”

Further, because Hashimoto fails to disclose an annular sealable passageway of any sort, Hashimoto also fails to include a formable material that is “disposed through the annular sealable passageway and into the cavity,” as recited by each of claims 54-60, 62, and 63.

Likewise, David fails to disclose or suggest a writing instrument having a deformable sleeve that includes “respective ends of the base and outer membrane being **oriented in the same direction and facing away from** the second end of the

elongate body,” and “a formable material disposed through the annular sealable passageway and into the cavity,” as recited by each of claims 54-60, 62, and 63. Rather, the moldable handle adapter for golf clubs and tennis rackets in David is essentially a closed pouch having two sections, a larger section 10 and a smaller section 12 joined by a lap joint 14 (col. 2, lines 21-24; *see also* Fig. 1). David teaches that the overlapping walls 16 and 18 should form a strong lap joint 14 that is closed and impenetrable (*see, e.g.,* col. 2, lines 40-43 and col. 5, lines 31-34). However, the ends of the overlapping walls 16, 18 face opposite directions. *See* David, Fig. 8. Thus, David fails to disclose or suggest a writing instrument, let alone a writing instrument having a deformable sleeve that includes “respective ends of the base and outer membrane being **oriented in the same direction and facing away from the** second end of the elongate body,” as recited by each of claims 54-57, 59-60, 62, and 63.

Furthermore, David also fails to disclose or suggest “a formable material disposed through the annular sealable passageway and into the cavity,” as recited by each of claims 54-60, 62, and 63. Rather, the two half pouches 10, 12 in David are already filled with two different types of material prior to forming the lap joint 14 so as to keep the material in each pouch separate until the molded handle is ready to be formed. *See* David, col. 2, lines 29-46. More specifically, because the two different materials rapidly harden when brought into contact with one another, the materials must be kept separate by the lap joint 14 until the handle is formed. *Id.* As such, David teaches away from disposing a formable material through an annular sealable passageway.

Because neither Hashimoto nor David discloses or suggests a writing instrument having a deformable sleeve that includes “respective ends of the base and outer membrane being **oriented in the same direction and facing away from the** second end of the elongate body” and “a formable material disposed through the annular sealable passageway and into the cavity,” as recited in claims 54-60, 62, and 63, no combination of Hashimoto and David can render any of the pending claims obvious. Thus, the applicants respectfully request withdrawal of the rejection, and allowance of claims 54-57, 59-60, 62, and 63.


Claim Objection

Because independent claim 54 is allowable, as shown above, the applicants respectfully submit that the objection to claim 61 is moot and should be withdrawn.

Conclusion

In light of the foregoing amendments and remarks, reconsideration and allowance of pending claims 54-57, and 59-63 are respectfully solicited. No fees are believed due. However, if there are any other fees or refunds required, the Director's designee is authorized to charge or debit Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP. A copy of this paper is enclosed herewith.

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to contact the undersigned at the indicated telephone number.

July 10, 2007	<p>Respectfully submitted,</p> <p>MARSHALL, GERSTEIN & BORUN LLP</p>  <hr/> <p>Michael A. Chinlund, Reg. No. 55,064 Agent for Applicants 6300 Sears Tower 233 S. Wacker Drive Chicago, Illinois 60606-6357 (312) 474-6300</p>
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